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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/656,414	09/06/2000	Hiroshi Tamura	2271/63036	9526

7590 03/31/2006  
Cooper & Dunham LLP  
1185 Avenue of the Americas  
New York, NY 10036

EXAMINER

GRANT II, JEROME

ART UNIT PAPER NUMBER

2625

DATE MAILED: 03/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/656,414	Applicant(s) TAMURA, HIROSHI	
	Examiner Jerome Grant II	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-45 is/are allowed.
- 6) ☒ Claim(s) 46-50, 55-59 and 63 is/are rejected.
- 7) ☒ Claim(s) 51-54 and 60-62 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

JEROME GRANT  
PRIMARY EXAMINER

JEROME GRANT  
PRIMARY EXAMINER

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### Detailed Action

1.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 46, 55 and 63 are rejected under 35 U.S.C. 102(e) as being anticipated by Wing.

With respect to claim 46, Wing teaches a transmitting device 200 comprising: an inputting device 224 configured to receive a request for transmitting image information to a receiving device 222; a transmitting unit (gateway 206) configured to transmit the image information to the receiving device 222; a mailing creating unit 208 configured to create a mail for notifying a result of the transmission of the image information after the transmission of the image information is completed and a mail transmitting unit 218 to transmit the mail to the address corresponding to the request.

Wing also teaches wherein the mail (fax message) includes an additional information ( DSN and MDN response according to col. 10, lines 40-48) which carries information about the transmission. Note, the DSN and MDN generate the additional information about the transmission which is specifically taught at col. 9, lines 30-37.

With respect to claim 55, Wing teaches a transmitting device 200 comprising: an inputting device 202, configured to receiving a request for transmitting image information to a receiving device 222; a transmitting unit (gateway 206) configured to transmit the image information to the receiving device 222; first mail creating unit 208 configured to create the first mail for notifying successful transmissions as claimed; first mail transmitting unit 218 for the purpose claimed; second mail creating unit 212 as claimed and a second mail transmitting unit 220 configured to transmit the second mail to the address according to the request.

Wing also teaches wherein the mail (fax message) includes an additional information ( DSN and MDN response according to col. 10, lines 40-48) which carries information about the transmission. Note, the DSN and MDN generate the additional information about the transmission which is specifically taught at col. 9, lines 30-37.

With respect to claim 63, Wing teaches indicating a reception ability information regarding the transmission which is set forth by col. 9, lines 30-37.

2.

Claims 47-50 and 56-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wing.

With respect to claims 47-50 and 56-59, see col. 7, lines 7-11 of the Wing reference which teaches the regulation of the MDN and the DSN as claimed.

What is not shown by the reference is that the DSN or the MDN is not in the mailer but is in unit 206.

However, it would have been obvious to one of ordinary skill in the art as a matter of design, to modify the mailer creating unit 208 so that it creates the notification instead of the unit 206. Since applicant does not suggest why one unit for providing the notification is preferred over the other, it would have been obvious to modify Wing so that the notification is provided in unit 208 as opposed to unit 206.

3.

**Claims Objected to As Containing Allowable Matter**

Claims 51-54 and 60-62 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4.

**Examiner's Remarks**

Applicant's remarks have been considered and are persuasive with respect to several points but not with regard to one point. As to the argument made at second full paragraph at page 23 of the remarks, the limitations applicant argues as distinct from Wing are objected to as containing allowable subject matter with the exception of the reception ability information. The examiner contends this limitation is taught according to col. 9, lines 30-37.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

5.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 571-272-7463. The examiner can normally be reached on Mon.-Thurs from 9:00 to 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore, can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Grant II

NEPOME GRANT II  
PRIMARY EXAMINER